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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,697	01/09/2002	Carl R. Jacobs	52646-404USP	7702

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EXAMINER
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JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/043,697

Applicant(s)

JACOBS, CARL R.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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### **Response To Applicant's Arguments**

First, the Applicant's remarks regarding the comments on claim 10 are not plausible and the comments are still valid or relevant.

Second, Applicant argues, regarding claims 1, 9, 16 and 20, that "neither Wilson nor Giordano expressly discloses determining a modified price for services as a function of the determined identity of the customer, regardless of whether the customer purchases any fuel".

In reply, the Examiner completely and respectfully disagrees with the Applicant's remarks.

Broadly interpreted, the argued limitation recites providing a discounted price for a service to an identified customer **whether or not the customer purchases any fuel (i.e. the identified receives a discount on a service if he buys fuel or if he does not buy any fuel)**. Here, either Wilson or Giordano teaches, as featured in the Office Action and in the prior art itself, providing a discounted or modified price on a service, such as a car wash service, to an identified customer, identified via a communication device or transponder, during a fuel transaction or fuel purchase (providing a discount or a 100% discount or a free service or car wash service to an identified customer based on a fuel transaction).

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the last Office Action, as shown below, is hereby maintained and the current **Office Action has been made Final**.

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## **DETAILED ACTION**

### ***Specification***

#### **General Comments**

Regarding claim 10, "providing the available discounted service to the customer at no charge if the customer does not purchase any fuel" appears to be confusing since independent claim 9 recites --providing a discounted service to the customer based on the type of payment instrument used by the customer--. At least, one condition should be met before the discount on the service can be provided to the customer.

It appears that claim 16 should be re-written as a computer readable medium storing instructions, when executed on a processor, perform the necessary steps.

#### **Status of the claims**

Claims 1-28 are pending in the Instant Application while claims 1-58 have been canceled.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson, USP 6,813, 609B2.

As per claims 1-28, Wilson teaches a system or a fuel dispensing system including a fuel dispenser associated with a control system and a receiver adapted to receive signals, including identification indicia from a remote communications unit (transponder, handheld device, fob, etc.) associated with a customer when a cash, credit or pre-paid transaction is indicated within an establishment or gas station. A cash transaction indicator is adapted to signal the control system that a cash transaction (type or method of payment) is taking place, and may be selectable by the customer or an operator of the system at the beginning of the transaction. The system also includes a transmitter adapted to transmit the customer-related information to the remote communication unit (transponder) associated with the customer where it is locally stored or has memory for storing the customer-related information in association with the identification indicia. The system is further configured to store credit for change due to the customer based on a cash transaction and provide and store loyalty points on or in association with the customer's transponder (See abstract).

The present system keeps track of cash customers and their respective refunds and loyalty points using transponder technology. Basically, a cash customer either carries a transponder or has a transponder mounted on his vehicle wherein the transponder is used to associate any refunds or loyalty benefits with the otherwise invisible cash customer. The operator can monitor the cash customer via the transponder. In practice, the customer uses the cash acceptor of the fuel dispenser and receives any change as credit with the transponder. The transponder may simply provide an ID where the central control system or a remote host network keeps track of the refund for later credit (i.e. the host computer stores the customer's credit or change due in a system database for later retrieval and use). Alternatively, the refund amount or credit may be

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transmitted directly to and stored on the transponder. In either embodiment, the amount stored in association with the transponder may be used as a credit during a subsequent fueling or retail purchase transaction (Col. 2: 6-19).

In addition to storing credit for the change due based on a cash transaction, loyalty points (promotions) are provided and stored on or in association with the transponder (loyalty points are stored in the memory of the transponder-Col. 2: 42-44).

Another aspect of the present system is a fuel dispenser system providing a customer input device, display and interrogator associated with a dispenser control system. The customer input device and display are adapted to provide a customer interface. The interrogator is adapted to communicate with a remote communications unit associated with the customer. The customer interface is adapted to provide a cash transaction input for the customer to select a cash transaction. The control system is adapted to operate in conjunction with a remote control system to provide customer information associated with the remote communications unit (transponder) when a cash transaction is selected. The customer information may relate to change due a customer as a result of a cash transaction and/or loyalty benefits based on a cash transaction. The customer information may be stored on the remote communications unit or in association with a remote communications unit identifier in a database accessible by the control system. The control system may include a dispenser controller, central site controller, remote network control system or any combination thereof (col. 2: 52 to col. 3: 4).

Additionally, the present system is configured to provide various types of **loyalty** benefits based on **past** and/or current transactions. **Loyalty** benefits will be provided to a customer in

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order to encourage subsequent return to a particular fueling environment or one of an associated group of environments. The benefit may also encourage the purchase of additional products during the current or a subsequent transaction. The benefits may include cash rebates or discounts providing a type of electronic couponing to enhance merchandising and marketing efforts. A loyalty point may be earned by a customer for each transaction, transaction amount or type or quantity of a particular product or service. For example, a loyalty point may be earned for each gallon of gas purchased or for a fill-up requiring eight or more gallons of gas. The store operators have tremendous flexibility in determining the various criteria for earning loyalty points. Additionally, the loyalty benefits or points (stored in the customer's transponder memory) are preferably redeemed by a customer in part or in whole on subsequent visits to the same or an associated fueling environment when the customer's presence is detected within an establishment via his transponder storing at least the customer's identification or indicia. Redeeming points at a subsequent transaction provides an incentive for a customer to return to environments participating in the benefit program. **Although redeeming points on a subsequent purchase is preferred, however, benefits may be made immediately available based solely on the current transaction, especially if the customer is using cash to pay for the transaction (wherein the benefits (discount coupon), provided during the current transaction, may be redeemed immediately on merchandise sold at convenience store 20, on car wash service available at remote car wash facility 24 and on food items sold at quick serve restaurant 22 of fig. 1 and wherein the remote car wash 24 equipment or terminal, the quick serve restaurant 22 equipment or terminal and the convenience store 20 equipment or terminal are coupled to the fuel dispensing system and wherein the benefits**

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(coupon) may be encoded or stored on the customer's transponder for later use and the customer receives a printed receipt that he presents, for example, at the car wash facility 24 to receive the discounted car wash service, especially if the customer does not have or carry a transponder). Furthermore, the benefits may be based upon current and **prior** transactions and allow for both current and subsequent benefit (col. 13: 43 to col. 14: 58; col. 14: 59 to col. 15: 60; col. 8: 29 to col. 11: 4; figs. 1, 5 and 10C).

See col. 15: 63 to col. 19: 8; figs. 26A and 9; col. 11: 5-20.

**The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless -**

**Claims 16-19 and 20-28 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/24689 to Giordano.**

As per claims 16-28, Giordano discloses a method of and a system for providing a fuel dispenser (14) with radio frequency customer identification capabilities via customers' transponders (wireless devices) mounted on vehicles or handheld (key chain, fob, etc.) transponders. The system and method determine whether a transponder (23, 25) containing customer identification data is within (proximity) range of a dispenser (14) that requires activation by the customer to initiate a transaction, such as a fuel transaction, and has an associated reader (20) for emitting radio frequency signals and receiving customer identification data from the transponder (23, 25) responsive to the emitted radio frequency signals (detecting the presence of a customer within a business establishment). When the transponder (23, 25) is



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within range of the dispenser, an in-range indication is provided to the customer. Upon activation of the dispenser (14) following a determination that the transponder (23, 25) is within range, the customer identification data (CID) received by the reader (20) is associated with a transaction at the activated dispenser. The transaction at the activated dispenser (14) is then permitted and charged to the customer's account according to the customer identification data as read from the transponder (once the customer is properly identified, the transaction is allowed according to a generated or pre-determined plan or the customer's account and the value of the transaction value or balance due is charged to the customer's account). Further, Giordano teaches providing loyalty benefits to the customer, based on the customer's profile (tracking or monitoring data or purchase history), during the transaction conducted via the transponder or remote communication unit, in which the customer's account is charged accordingly.

Tracking data and/or business data and/or security data may be written to a R/W (read/write) transponder. Further, preference information related to the buying experience of the customer or buyer may be written to the memory of the transponder. The transponder can be connectable by a suitable interface to microprocessors such as a vehicle's on-board computer so that, in cooperation with the system (10), information, such as fuel economy calculations, miles traveled since the last fill up, engine conditions and the like, can be written to the transponder and then displayed to the customer while fueling.

Following a validation process, at the POS, a sale is permitted wherein the customer can dispense fuel and/or order goods, such as food, services, car wash at the pump, all which is charged to the customer's account identified by the transponder. The system may offer, by displaying a promotional message on a display (CAT) terminal, to the customer a free car wash

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if the customer has purchased fuel a certain number of times. Customer's information is stored in the system database. The system or host can also store a copy of the customer's information into the customer's transponder memory, which is periodically updated by the system.

Finally, the system or network keeps track of the customer's past purchases and buying preferences and provides rewards for frequent purchases. When a transponder is read at a business facility, the CAT or terminal, related to the fuel dispenser, can display a message indicating rewards, **such as a free car wash, that the customer is entitled to.** The network or system also stores the customer's profile, such as name, address, payment account information, preferred method of payment, preferred language and so forth, and provides customized service for the customer based on the stored profile.

See abstract; figs 1-31; page 5: 9 to page 6: 17; page 13: 15 to page 24:16; page 30: 22-32; page 35: 32 to page 36: 20; page 55: 5-25.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft -571-273-8300 :

04/14/07

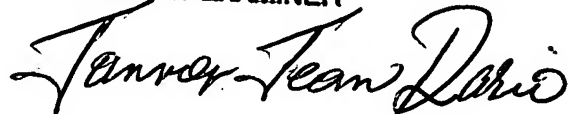
JDJ

Jean D. Janvier

Patent Examiner

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**JEAN D. JANVIER  
PRIMARY EXAMINER**

A handwritten signature in cursive script that reads "Janvier Jean D." followed by a stylized flourish.